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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/254,058

06/14/1999

CHEOL KIM

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6431

24335

7590

09/11/2002

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/254,058

Applicant(s)

KIM, CHEOL

Examiner

Kathleen M Christman

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/02/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-15, 32, 33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-15, 32, 33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

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### **DETAILED ACTION**

In response to election filed 07/02/02, claims 16-31, 34, and 36-50 have been cancelled, claims 6-15, 32, 33, and 35 are pending. Claims 1-5 were cancelled by the preliminary amendment filed 10/06/00.

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I claims 6-15, 32, 33, and 35 in Paper No. 8 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 6-15, 32, 33 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with antecedent basis issues. This includes the continual substitution of "a language learning terminal" with "the terminal" and what appears to be the phrases "language learning caption data" used interchangeably with "the caption data". This substitution renders the claims indefinite, as it is unclear whether these phrases actually refer to the same information or are intended to be distinct limitations. The phrase "the captions of the caption data" in claim 8 is another example. Further the phrase "from the outside" in claim 6 is vague and indefinite. The term is not defined by the claim and what constitutes "the outside" is not clearly set forth. The word "flesh" in claim 14 appears to be a misspelling of the word "flash".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 6-13, 15, 32, 33 and 35, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Onishi et al (US 5572260). Onishi et al teaches an English learning apparatus which can read on the language learning terminal as claimed. The communication interface is merely the circuitry which is required for the "video cassette recorder" to communicate with the system. There is a first memory described as a non-display data by Onishi. The controller, decoder, and display are clearly shown in Figure 1 (and also in Figure 6 labeled as prior art). Caption data being synchronized with audio data (claims 7 and 33) is shown taught with the statement: "When a closed caption system is used for a language study, a caption pause function to stop displaying subtitles is necessary in order to match the speed of flowing subtitles on a screen with the speed at which a user can understand the voice from the video cassette tape. Further, for a video software tape in which the other language such as Japanese has already been superimposed on the tape, it is necessary to mask Japanese language subtitles by changing the position of the closed caption." Col. 1: 33-41. The mark numbers of claims 8-15 are shown in figure 3, and their use in the system is shown in col. 5: 11-28. The memories being removable is shown in the actual memories are VHS tapes which are removable from the system. The use of RAM is shown at col. 5: 17. Volume controls are inherent to these systems.

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**Conclusion**

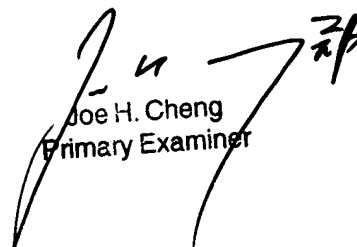
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Kaminski (US 5273433) teaches the use of captions in a learning method
  - b. Salomon et al (US 5519443) teaches a system for producing captions in a system, includes the use of the system for learning acquisition
  - c. JP407261652A and abstract, teaches using captions in a learning system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Kathleen M. Christman  
Patent Examiner  
August 28, 2002

  
Joe H. Cheng  
Primary Examiner